

REMARKS

Claims 3 and 5 are canceled without prejudice, and therefore claims 1, 2, 4 and 6 to 14 are pending.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to the objections as to claims 5 to 7, while the rejections of the underlying claims may not be agreed with, to facilitate matters, claim 1 has been rewritten to include the features of claim 5 and its base claim 3, both of which have been canceled without prejudice. Claim 7 now depends from claim 1. Accordingly, claim 1 is allowable, as are its dependent claims, including claim 7. It is therefore respectfully requested that the objections as to claims 5 to 7 be withdrawn.

With respect to the Office Action, claim 8 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

While the rejection may not be agreed with, to facilitate matters, independent claim 8 has been rewritten so as to obviate the indefiniteness rejections, so that claim 8, as presented, is plainly definite. No new matter has been added and the claim as written is supported by the present application, including the specification at lines 17 to 20 of page 6. It is therefore respectfully requested that the definiteness rejection be withdrawn, since claim 8, as presented, is allowable.

Claims 1, 2, 8, 9 and 14 were rejected under 35 U.S.C. § 102(b) as anticipated by Hofsaess et al., U.S. Patent No. 5,522,040.

As regards the anticipation rejections of the claim, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejection, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to

reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the anticipation rejections may not be agreed with, to facilitate matters, claim 1 has been rewritten to include the features of claim 5 and its base claim 3, both of which have been canceled without prejudice. Claim 7 now depends from claim 1. Accordingly, claim 1 is allowable, as are its dependent claims, including claims 2, 8 and 9.

As to claim 14, it now includes features like those of claim 1 and is therefore allowable for essentially the same reasons.

It is therefore respectfully requested that the anticipation rejections of claims 1, 2, 8, 9 and 14 be withdrawn.

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as obvious over Hofsaess et al., U.S. Patent No. 5,522,040, in view of McCurry et al., U.S. Patent No. 5,184,025.

Claim 3 has been canceled without prejudice since its features have been included in claim 1, together with those of canceled claim 5. Claim 4 depends from claim 1, as presented, and is therefore allowable for essentially the same reasons since the secondary reference does not cure the critical deficiencies of the primary reference.

Claim 10 was rejected under 35 U.S.C. § 103(a) as obvious over Hofsaess et al., U.S. Patent No. 5,522,040, in view of Shonaka, U.S. Patent No. 4,809,280.

Claim 10 depends from claim 1, as presented, and is therefore allowable for essentially the same reasons since the secondary reference does not cure the critical deficiencies of the primary reference.

Claims 11 and 13 were rejected under 35 U.S.C. § 103(a) as obvious over Hofsaess et al., U.S. Patent No. 5,522,040, in view of McCurry et al., U.S. Patent No. 5,184,025, and in further view of Shonaka, U.S. Patent No. 4,809,280.

While the obviousness rejections may not be agreed with, to facilitate matters, claim 11 has been rewritten to include features like those of claim 5 and its base claim 3, both of which have been canceled without prejudice. Accordingly, claim 11, as presented, is allowable for essentially the same reasons as claim 1, as presented, as is dependent claim 13, since the secondary references do not cure – and are not asserted to cure -- the critical deficiencies of the primary reference.

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Claim 12 was rejected under 35 U.S.C. § 103(a) as obvious over Hofsaess et al., U.S. Patent No. 5,522,040, in view of McCurry et al., U.S. Patent No. 5,184,025, and in further view of Shonaka, U.S. Patent No. 4,809,280., and in further view of the EEPROM definition.

While the obviousness rejections may not be agreed with, to facilitate matters, claim 11 has been rewritten to include features like those of claim 5 and its base claim 3, both of which have been canceled without prejudice. Accordingly, claim 11, as presented, is allowable for essentially the same reasons as claim 1, as presented, as is dependent claim 12 since the secondary references do not cure – and are not asserted to cure -- the critical deficiencies of the primary reference.

Accordingly, claims 1, 2, 4 and 6 to 14 are allowable.

CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending claims 1, 2, 4 and 6 to 14 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since they have been obviated. Since all issues raised have been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully Submitted,

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